Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUW DAVID JONES
and KENT PATRAS

Appeal No. 2001-2139
Application 09/189,643

ON BRIEF

Before COHEN, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

## DECISION ON APPEAL

Huw David Jones et al. appeal from the final rejection of claims 6 through 10, all the claims pending in the application.

## THE INVENTION

The invention relates to "a method for coating a blood sample collection tube" (specification, page 1). Representative claim 6 reads as follows:

6. A method for coating a blood collection tube comprising spraying a solvent dispersion of an additive to the inside wall surface of a collection tube with an air nozzle and drying said wall surface to leave a coating of additive particles on said wall surface.

## THE REJECTION

Claims 6 through 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,906,744 to Carroll et al. (Carroll).

Attention is directed to the appellants' brief (Paper No. 11) and to the examiner's answer (Paper No. 12) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.[1]

## DISCUSSION

Carroll discloses a blood collection device 10 in the form of a plastic or glass tube having an open end 16, a closed end 18, an inner wall 12 and a stopper 14. The tube contains a thixotropic polymeric gel 20 at its closed end 18

[1] In the answer (see pages 2 and 3), the examiner changed the statutory basis for the appealed rejection from § 102(a) to § 102(e). Given the issues at bar, this change is of no practical moment and does not prejudice the appellants in any way.

for separating plasma from whole blood and an anticoagulant coating 22 on its inner wall 12. The device is produced by a method wherein

> [t]he thixotropic polymer gel is first deposited into a tube at the closed end, then the anticoagulant formulation . . . is applied onto the inner wall of the tube above the gel in the form of a fine mist by spray coating. The applied formulation is then dried by air jet or forced air at an elevated temperature for a
>
> period of time. Thereafter, the tube is assembled with a closure and a vacuum is formed inside the tube. The device is then sterilized by gamma irradiation or the like [column 5, lines 8 through 16].

As for the particular manner in which the anticoagulant formulation is spray coated onto the inner wall of the tube, Carroll teaches that "[i]t is preferable that the anticoagulant formulation is metered and dispensed by a volumetric type device, such as a positive displacement pump. . . . Other spraying techniques include ultrasonic spraying" (column 5, lines 39 through 45). Carroll further explains that

> [t]he main advantages of a tube with a spray coated anticoagulant formulation on the inner wall are more precise, stable and uniform anticoagulant fill and improved anticoagulant dissolution into the specimen. Because of the fine mist of the anticoagulant formulation, the actual surface area

> of anticoagulant formulation exposed to the specimen is maximized [column 5, lines 18 through 24].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

As framed by the appellants, the dispositive issue in the appeal is whether Carroll meets the limitation in claim 6 requiring the solvent additive dispersion to be sprayed on the inside wall of the tube "with an air nozzle." According to the appellants, "the claimed spraying with an air nozzle is an undisclosed species within [Carroll's] disclosed genus of fine mist spraying" (brief, page 3). The examiner, on the other hand, submits that "the type of spraying disclosed by Carroll inherently requires an air nozzle to produce the mist. The mist cannot be created without an air nozzle" (answer, page 5).

Page 5 in the appellants' specification states that "[a] suitable air nozzle design for use in this invention is that disclosed in US Patent No. 5,732,885 [to Huffman] after being modified to fit into a blood collection tube." The disclosure

of the Huffman patent (which is of record) confirms what is manifest: that an "air" nozzle is one which issues a stream of pressurized air. In terms of an air nozzle sprayer, the stream of pressurized air functions to atomize the fluid being sprayed. In short, the examiner has not advanced any evidentiary basis to support the assertions that the type of spraying disclosed by Carroll inherently requires an air nozzle to produce a mist and that a mist cannot be created without an air nozzle. Indeed, Carroll's teaching that the spray coating step disclosed therein may be performed by ultrasonic spraying seems to belie the examiner's position.[2]

Thus, the Carroll reference does not provide the factual basis necessary to find that it discloses each and every element of the invention recited in claim 6. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(e) rejection of claim 6, and dependent claims 7 through 10, as being anticipated by Carroll.

REMAND

[2] The examiner does not dispute the passage in the appellants' specification (see page 3) differentiating an air nozzle from an ultrasonic nozzle.

This application is remanded to the examiner to consider whether the combined teachings of Carroll and the Huffman patent cited by the appellants would have suggested the subject matter recited in the appealed claims, thereby warranting an appropriate rejection under 35 U.S.C. § 103(a).

SUMMARY

The decision of the examiner to reject claims 6 through 10 is reversed and the application is remanded to the examiner for further consideration.

REVERSED and REMANDED

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| IRWIN CHARLES COHEN<br>Administrative Patent Judge | ) |
| LAWRENCE J. STAAB<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| JOHN P. MCQUADE<br>Administrative Patent Judge | ) |

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